

REMARKS

Claims 1, 2, 7, 9, 10, 12, 13, and 15-20 are currently pending. Claims 1, 7, 9, 12, 13, and 16 have been amended. Claim 14 has been canceled. The amendments to claims 7, 9, 12, 13, and 16 are to correct claim dependencies or minor typographical errors and therefore do not create any type of prosecution history estoppel. Reconsideration of this application in light of the above amendments and the following remarks is requested.

Rejections under 35 U.S.C. § 103

Claims 1, 2, 7, 9, 10, 12, 13, and 15-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,777,326 to Rockwood et al. (Rockwood) in view of U.S. Patent No. 5,077,470 Cody et al. (Cody). Applicant respectfully traverses these rejections, and reconsideration of Applicant's pending claims is requested.

The references fail to teach or suggest each element of the claims

As the PTO provides in MPEP § 2143, “[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Furthermore, under MPEP § 2142, “[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 1, as amended, recites in part "attenuation means and means for generating secondary electrons from said ions, wherein the attenuation means are placed before the means for generating secondary electrons and act to attenuate the quantity of ions reaching at least one said detector element relative to another of the at least two detector elements."

The Office action states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the methods of and apparatus of Rockwood and Cody et al. and add features like attenuation means."

(para. 5). However, the text of Rockwood (col. 4, lines 4-7) relied on by the Examiner simply states that "[m]ost importantly, the TDC has excellent signal averaging properties which improve linearly as the square root of time with respect to the detection limit over time." Nowhere does the cited text of Rockwall teach or even suggest using an attenuated/unattenuated signal combination, as is recited in claim 1.

Accordingly, the cited references fail to teach each element of claim 1 as required by MPEP § 2143, and claim 1 is allowable. Claims 2, 7, 9, 10, 12, 13, and 15-20 depend from and further limit claim 1 and are allowable for at least the same reason as claim 1.

Applicant requests references to support the assertion of obviousness

The Office action states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine methods and apparatus of Rockwood and Cody et al. and add features like attenuation means for secondary electrons generated by the ions hitting the detector" The Applicant respectfully traverses this assertion and, as permitted under MPEP § 2144.03, requests that the Examiner cite a reference in support of his position for each rejected claim.

Alternatively, if the Examiner is relying on the Examiner's personal knowledge as the basis for these assertions, Applicant respectfully objects to the Examiner's use of official notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." (Emphasis added). When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. 37 CFR 1.104(d)(2). Pursuant to 37 CFR 1.104(d)(2), the Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may explain the reference.

Conclusion

In light of the above amendments and remarks, all pending claims are now believed to be in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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Date: April 15, 2004

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee Amendment, Commissioner For Patents, PO Box 1450 Alexandria, VA 22313-1450 on April 15, 2004.

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